

In re: Thomas Zickell  
Filed: July 3, 2001  
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REMARKS

This is a complete response to the outstanding final Office Action mailed December 12, 2007. The Applicant traverses all of the objections and rejections of the Office Action. Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the following remarks.

I. Response to Claim Rejections Based on Obviousness

In the Office Action, claims 45-66 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennepohl et al. (U.S. Patent No. 4,079,158, hereinafter referred to as "Kennepohl") in view of Simpson et al. (U.S. Patent 5,096,759, hereinafter referred to as "Simpson") in further view of McGroarty et al. (U.S. Patent 5,079,088, hereinafter referred to as "McGroarty"). Applicant respectfully traverses this rejection.

Applicant urges that the Examination lacks the evidence, facts, or findings sufficient to establish a *prima facie* case of obviousness. To establish a *prima facie* basis for obviousness, the Office bears the burden to show a factual basis for the rejection.

*In re Warner*, 379 F.2d 1011, 389 U.S. 1057 (1968). Such basis must be both factually sufficient, and reasonable.

The Office bears the burden to show specific motivation to combine references, and to support the motivation for each combination, as well as the substance behind each rejection, with factual references. However, the Office ignores the great many factors that tend to demonstrate that the references are not combinable, and also ignores the lack of indicia that would lead one to combine the references to obtain the invention. These reasons, expounded upon below, create a compelling and legally sufficient basis to demonstrate that not even a *prima facie* basis for a rejection exists, and that the Applicant's claims are entitled to allowance without further rejection.

A. No teaching of a second region substantially free of the adhesive

None of the references teach or suggest "a lower surface of the second region substantially free of the adhesive composition". The Office cites to the adhesive layer (item 94 of Simpson) and release backing (item 96 of Simpson) as disclosing "an adhesive composition layer contacting a lower surface of the first region"

but ignores the claim limitation of "a lower surface of the second region substantially free of the adhesive composition". Simpson discloses the adhesive layer completely covering the bottom surface of the non-woven polyester mat 92. Simpson does not disclose, teach, or suggest a lower surface of the second region substantially free of the adhesive composition.

The Office makes no attempt to find or cite such a teaching. When addressing this element, the Office ignores the exact claim language "a lower surface of the second region substantially free of the adhesive composition." Simpson does not disclose, teach or suggest an adhesive composition disposed on a portion of the bottom surface. Simpson discloses the adhesive layer completely covering the bottom surface of the non-woven polyester mat 92 including the non-overlapping portion of the polyester mat 92, which after being installed does contact the support surface.

In view of Simpson disclosing the adhesive layer completely covering the bottom surface of the non-woven polyester mat 92, one skilled in the art would have completely covered the bottom surface of the substrate with an adhesive layer. No citation is made for the Office's leap in logic. Federal Circuit Judge Newman, in her opinion in *In re Lee*, 277 F3d. 1338, 1343, 61

USPQ2d 1430 (Fed Cir. 2002), says it well: "findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability." The Offices reasoning seems to be merely reaching or using impermissible hindsight in an attempt to avoid allowing a novel and non-obvious claim to issue.

B. No basis for combining references and combination of reference teachings do not suggest Applicant's claimed invention.

None of the references teach or suggest "an upper surface of the second region substantially free of the second asphalt composition". No proper basis exists for combining McGroarty with Simpson or Kennepohl. The CCPA earlier expressly held that there must be some logical reason apparent from the evidence of record that would justify a combination or modification of references. *In re Regel*, 188USPQ 132 (CCPA 1975). In determining whether one of ordinary skill in the art would find it obvious to modify or combine references, the teachings of the reference taken with the knowledge that a worker in the art already possesses constitute the scope and content of the prior art that is referred to in the Graham decision. Thus, the question raised under § 103 is whether

the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art. Accordingly, even if all elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention. *In re Regel, supra.* Where no reasonable intrinsic or extrinsic justification exists for the proposed combination or modification, *prima facie* obviousness will not have been established, and no such justifications exist between McGroarty and Simpson or Kennepohl, thus, no *prima facie* case of obviousness has been established. These principles are applied in more detail, below.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to

the insidious effect taught is used against the teacher." See *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 At 1369, 55 USPQ2d at 1316) (Fed. Cir. 2000).

McGroarty is directed to waterproofing panels of bentonite clay. McGroarty utilizes several layers of bentonite under a sealing membrane to provide panels that are installed next to each other. The bentonite system necessitates that the bentonite clay, which absorbs moisture, be under a waterproof membrane. The waterproofing system of bentonite clay disclosed in McGroarty is a different system and application from the asphalt shingle application of Applicant, Simpson, or Kennepohl. One skilled in the art of asphalt roofing shingles would not look to the bentonite clay system of McGroarty.

The bentonite clay system of McGroarty requires the additional sealed membrane to provide a waterproof seal on top of the layer of bentonite clay. Therefore the sealed membrane must overlap to make contact with the membrane of adjacent panels; providing a unified membrane instead of an overlapping, sandwich structure in asphalt shingle systems. The asphalt shingle systems do not need or have the additional water sealing membrane (element 10) over top the asphalt shingles. In addition, the panelized

bentonite clay system of McGroarty has a relatively thick layer of bentonite clay, which prevents the overlap of the bentonite clay layer. No reasoning is provided why one skilled in the art at the time of the invention would not have an upper surface completely covered by the second asphalt composition and overlapped the substrate and second asphalt composition as taught by all the prior asphalt systems cited by the Office. The Office obviousness rejection lacks reasoning why one skilled in the art at the time of the invention would look to the system of McGroarty to address issues specific to McGroarty waterproofing system and not faced by an asphalt roofing shingle system. The cited teachings of McGroarty are specific to the panelized bentonite clay system of McGroarty. The Office again seems to be merely reaching or using impermissible hindsight in an attempt to avoid allowing a novel and non-obvious claim to issue.

II. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

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CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and rejections have been traversed, rendered moot and/or accommodated, and that presently pending claims 45-66 and 44 are in condition for allowance. Favorable reconsideration and allowance of the present application and the presently pending claims are hereby courteously requested. The examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application

Respectfully submitted,

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